

REMARKS

Claims 1, 6, 7, 9 and 11-35 were pending. No claims have been amended. No claims have been added or cancelled. Accordingly, claims 1, 6, 7, 9 and 11-35 remain pending in the application subsequent entry of the present amendment.

35 U.S.C. § 121 RESTRICTION

In the present Office Action, the Examiner presented a restriction requirement requiring election of one of the following six inventions as defined by the Examiner:

- I. Claim 1, drawn to determining an offer based on round-up and genetic program or genetic algorithm, classified in class 705, subclass 14.
- II. Claims 6, 7, 12-26, drawn to a processor adapted to execute the step of determining an offer based on round-up and genetic program or genetic algorithm, classified in class 705, subclass 14.
- III. Claims 9, 11, drawn to calculating a difference between a transaction total and a next highest dollar amount and determining the offer based on the difference, classified in class 705, subclass 14.
- IV. Claims 27-33, drawn to classifiers (rules) in genetic algorithmic or programming, classified in class 706, subclass 13.
- V. Claim 34, drawn to initializing genetic algorithm or genetic program to generate offers, classified in class 706, subclass 13.
- VI. Claim 35, drawn to training an offer generation system in one environment and identifying a second environment to use the trained system, classified in class 706, subclass 12.

CLAIM GROUPINGS AND ELECTION

Applicant first notes that claim group II in the Office Action is generally deemed to correspond to “a processor adapted to execute the steps . . .” The claim grouping includes claims 6, 7, and 12-26. However, Applicant believes this to be an error and that the examiner intended claims 12-26 to be included in claim group I. Claims 12-26 are dependent on claim 1, a method claim, and not dependent on claims 6 and 7, which are device and medium claims, respectively. Therefore, for purposes of the following discussion, Applicant will assume the restriction requirement and claim groupings to be as follows.

- I. Claims 1 and 12-26 drawn to determining an offer based on round-up and genetic program or genetic algorithm, classified in class 705, subclass 14.
- II. Claims 6 and 7 drawn to a processor adapted to execute the step of determining an offer based on round-up and genetic program or genetic algorithm, classified in class 705, subclass 14.
- III. Claims 9, 11, drawn to calculating a difference between a transaction total and a next highest dollar amount and determining the offer based on the difference, classified in class 705, subclass 14.
- IV. Claims 27-33, drawn to classifiers (rules) in genetic algorithmic or programming, classified in class 706, subclass 13.
- V. Claim 34, drawn to initializing genetic algorithm or genetic program to generate offers, classified in class 706, subclass 13.
- VI. Claim 35, drawn to training an offer generation system in one environment and identifying a second environment to use the trained system, classified in class 706, subclass 12.

Applicant elects Invention I (claims 1 and 12-26), as defined by the Examiner, **with traverse.**

RESTRICTION IMPROPER

Applicant traverses the restriction requirement for at least the following reasons. In the present Office Action, the examiner

“[H]as required restriction between combination and subcombination inventions. . . . Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required.”

Applicant will first address the second of the above requirements for restriction.

No Serious Search and Examination Burden

Applicant first addresses the second of the above requirements for restriction noted above; namely, that there would a serious search and examination burden if restriction were not required. Applicant respectfully submits the record does not support this conclusion.

M.P.E.P. § 808 requires the Examiner to also show “reasons why there would be a serious burden on the examiner if restriction is not required”. In the Office Action, the Examiner seeks to satisfy this requirement by stating that one or more of the following apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant notes that the statement above simply provides a list of possible reasons for justifying a claim of serious burden, but no specific reason is called out with regard to any pending claim(s). Applicant submits simply providing a list of *possible* reasons for substantiating a claim of serious burden is not adequate to support a restriction requirement. For at least these reasons, Applicant asserts that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement.

Additionally, Applicant submits the evidence of record does not support the claim of serious burden. It is noted that each of claim groups I, II and III are designated by the examiner as all corresponding to not only the same class, but the same subclass (class 705, subclass 14). Similarly, both of claim groups IV and V are designated by the examiner as corresponding to a single class and subclass (class 706, subclass 13).

Still further, the subject matter of pending claims 1, 6, 7, 9, and 11-14 as identified in the above claim categories has been included in the present claims since at least August 4, 2004. Since that time there have been at least 6 (six) office actions examining the claims with no restriction requirement. It is noted these claims span all of claim groups I-III as identified in the present Office Action. Claims 15-26 were added August 23, 2006 and have been repeatedly examined without restriction.

Furthermore, nothing has changed in the application to require restriction at this late date. Applicant's note that the application has already received numerous actions on the merits. Although M.P.E.P. 811 does allow a restriction requirement to be made after an action on the merits "as soon as the need for a proper restriction requirement develops," there has been no change in the application that would have caused such a need to "develop." As noted above, the subject matter of pending claims 1, 6, 7, 9, and 11-14 as identified in the above claim categories has been included in the present claims since at least August 4, 2004. Claims 15-26 were added August 23, 2006. The fact that these claims have been examined over numerous actions on the merits demonstrates that there would be no serious burden on the Examiner to continue to examine all the claims in the same application. Therefore, restriction should not be required at this late date.

Since the Examiner's has failed to establish a "serious burden on the examiner if restriction is not required" as required by M.P.E.P. § 808, Applicant asserts that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement. Therefore, the Examiner's restriction requirement must be withdrawn.

Combination/Subcombination Restrictions Improper

Further to the above, claim 6 is an apparatus claim. It does not make sense to categorize apparatus claims with process claims as subcombinations of the same combination. Subcombinations are separate, non-overlapping components of the same combination. Two separate apparatuses could be subcombinations of an apparatus combination, or two separate processes could be subcombinations of an overall process combination, but an apparatus and a process cannot be separate subcombinations of the same combination. In regards to restrictable related inventions, there are other sections of the M.P.E.P. that apply to related apparatuses and processes (see sections 806.05(e), 806.05(f), 806.05(h) and 806.05(i)), but "subcombinations disclosed as usable together in

a single combination” (M.P.E.P. 806.05(d)) clearly does not apply to both apparatus and process claims together as a combination.

Further, Applicant believes the combination and subcombination restrictions to be improper for additional reasons. The Examiner contends that Inventions I, II, and III “are related as subcombinations disclosed as usable together in a single combination”; IV and I-III, V, and VI “are related as subcombinations disclosed as usable together in a single combination”; Inventions V and I-IV “are related as subcombinations disclosed as usable together in a single combination”; and Inventions VI and I-V “are related as subcombinations disclosed as usable together in a single combination” However, these Inventions are clearly not disclosed as being limited to subcombinations usable together in a single combination. The Examiner has misapplied the concept of subcombinations usable together in a single combination. Subcombinations are two separate, non-overlapping (i.e., mutually exclusive) components of a single combination. For example, a gear mechanism and a seat bracket would be two separate subcombinations that are usable together in a single bicycle combination. Inventions I-VI, as defined by the Examiner, do not have the relationship of subcombinations disclosed as usable together in a single combination. For example, it is clear from a review of the claims and specification that the method of claim 1 overlaps with the method of claim 27.

M.P.E.P. 806.05(d) states:

“Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.

>To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary. Each subcombination is distinct from the combination as claimed if:

(A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination. See MPEP § 806.05(c). Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search.”

“ . . . The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.”
(emphasis added)

On pages 3-5 of the present Office Action, the Examiner contends the six inventions shown above “are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.” However, the Examiner has not shown, by way of example, that any of the subcombinations has utility other than in the disclosed combination. The requirement for a separate utility requires more than just noting a difference in limitations in the claims. According to M.P.E.P. 806.05(d), “[t]he Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.” (emphasis added). In addition, M.P.E.P. 806.05(j) states for related product inventions, or related process inventions, the inventions are distinct if “the inventions as claimed do not overlap in scope, i.e., are mutually exclusive”.

The Examiner appears to have misunderstood the requirement for a subcombination to have utility other than in the disclosed combination. On pages 3-5 of the present Office Action, the Examiner merely points to differences between the claims. By definition, true subcombinations will always have different utility with respect to one another by their very nature of being separate and distinct non-overlapping components of a larger system (combination). The requirement of M.P.E.P. 806.05(d) is that a subcombination has a utility other than in the disclosed combination, not with respect to other subcombinations. Also, all the examples given by the Examiner clearly apply to the same overall combination(s) as

disclosed in the specification and these examples do not show groups I-VI above are non-overlapping.

For example, on pages 3-4 of the present Office Action, the Examiner highlights limitation differences between group III and the combination of groups I and II, but does not show group III has utility other than in the disclosed combination. The fact that group III recites a calculation, such as a “difference between a transaction total and the next highest dollar amount”, and recites using this calculation in order to determine an offer for a customer, does not show group III “has utility other than in the disclosed combination”. Groups I, II, and III, and, in fact, groups IV-VI, also recite determining an offer for a customer. Groups I-III recite many similar features and overlap in scope. Groups I-III are not mutually exclusive. Also, it is not shown that group III has “utility either by itself or in another materially different combination”. Rather, only a limitation difference in the claims is shown.

On page 3 of the present Office Action, the Examiner proposes groups I and II are distinct. However, groups I and II are not mutually exclusive as they have much overlap in scope. Also, neither group I nor group II “has utility other than in the disclosed combination”. These reasons alone show groups I and II are not distinct inventions. Additionally, the Examiner states the “invention of Group I do not require the apparatus of Group II since the invention of Group I can be done by hand or by mental steps.” However, M.P.E.P. 806.05(e) states “[t]he burden is on the examiner to provide reasonable examples that recite material differences.” A genetic algorithm is known to those skilled in the art as a search technique performed by a computer(s). By simply asserting “the invention of Group I can be done by hand or by mental steps”, Applicant submits the Examiner has not provided a reasonable example that recite material differences. For at least these reasons, the examiner has not shown groups I and II to be distinct inventions.

Additionally, in the second paragraph on page 4 of the present Office Action, the Examiner states “[i]n the instant case, invention IV has separate utility such as classifiers in genetic algorithmic or genetic programming. This separate use distinguishes the invention of

group IV from group I-III, V, VI since the use of classifiers in genetic algorithmic or genetic programming, is not limitation of those independently claimed inventions.” Here, the Examiner has noted a difference in limitations in the claims. However, the Examiner did not show, by way of example, that invention IV “has utility other than in the disclosed combination”. Rather, the Examiner points out invention IV bases a determination of an offer for a customer on a genetic program or a genetic algorithm that utilizes matching a particular bit stream to “one or more classifiers of a population of classifiers”. Embodiments of any of Applicants’ independent claims include offer generation to a customer and may involve basing a determination of an offer for a customer on a genetic program or algorithm that utilizes classifiers. The mere use of classifiers does not distinguish claims 27-33 as a separate invention from the other claims. The Examiner has not provided an example of a separate utility for Invention IV. Further, group IV is not mutually exclusive from the groups I-III, V and VI.

In regard to Invention V, the example given by the Examiner in the third paragraph on page 4 of the present Office Action is that Invention V has a separate utility for “initializing genetic algorithmic or genetic programming to generate offers.” However, it is clear from the specification that while this utility may be specifically recited in Invention V, it may apply to all of the claims as well as the disclosed combination(s). Generally speaking, initialization of any element does not provide a separate utility. In addition, the specific initialization of a recited genetic program or genetic algorithm does not provide a separate utility. Rather, these features are merely a difference in the limitations of the recited claims. Thus, the Examiner has not stated a separate utility. Also, once again, group V as claimed does overlap in scope with the other groups.

For Invention VI, the example given by the Examiner on pages 4-5 of the present Office Action is that Invention VI has a separate utility for “training an offer generation system in one environment and identifying a second environment to use the trained system.” The Examiner even adds “[t]his separate use distinguishes the invention of group VI from group I-V” since these features are “not limitation of those independently claimed inventions”. Each of groups I-VI may recite certain features that are not recited limitations

within one or more of the other independent claims, but these certain features, as shown above, do not show “utility other than in the disclosed combination”. Again, the requirement for a separate utility requires more than just noting a difference in limitations in the claims. According to M.P.E.P. 806.05(d), the Examiner must show “that one of the subcombinations has utility other than in the disclosed combination”. The “training of an offer generation system in one environment and identifying a second environment to use the trained system” is not a separate utility and could certainly be practiced in embodiments of the methods of claims 1, 9, 27 and 34, or in embodiments of the device of claim 6, or in embodiments of the medium of claim 7. Again, the Examiner has not provided an example of a truly separate utility. Further still, group VI does overlap in scope with groups I-V.

In summary, the Examiner’s restriction requirement is flawed for at least the following reasons: i) the Examiner has incorrectly characterized the claims as being limited to subcombinations disclosed as usable together in a single combination; ii) the Examiner has not shown a separate utility for any of the alleged subcombinations outside of the disclosed combination; iii) the Examiner has failed to establish a valid reason why there would be a serious burden on the examiner if restriction is not required; and iv) restriction at this late date is improper since nothing has changed in the application to develop a proper need for restriction. Thus, a prima facie requirement for restriction has not been stated and the restriction requirement is improper. Accordingly, withdrawal of the requirement for restriction is respectfully requested.

Further Discussion and Possible Alternative

In view of the above comments, the below signed representative is open to discussing alternatives to the proposed restriction requirement. For example, the Applicant may consider an alternative whereby claims 1-33 are elected for examination in the present application. Should the examiner wish to discuss further, the representative may be reached at 512-853-8866.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/6124-00100/RDR.

Respectfully submitted,

/ Rory D. Rankin /

Rory D. Rankin
Reg. No. 47,884
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin,
Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8800

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